

PATENT

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26. The method of producing an information display comprising the steps of:
soliciting from a particular vendor site various products which are to be promoted at
particular times of the year; and
preparing articles for inclusion in selective editions of said display, each said
commissioned article pertaining to one or more of said solicited products; and
distributing editions of said display to said vendor for distribution to patrons of said
vendor site.

27. The method of claim 26 further including the step of:
including, in association with each said prepared article, brand specific identification
of said product which pertains to said article.

28. The method of claim 26 further including, in association with each said
prepared article, brand specific identification of products other than said product pertaining to
said display.

REMARKS

Claims 1, 4, 10, 17, and 26-28 have been rejected by the Examiner and claims 18-25
have been withdrawn from consideration. Therefore, claims 1, 4, 10, 17, and 18-28 are
pending in the application. The outstanding issues in the present Office Action are:

- Claim 26 is rejected under 35 U.S.C. §102(b); and
- Claims 1, 4, 10, 17, and 27-28 are rejected under 35 U.S.C. §103(a).

Applicants hereby traverse the outstanding rejections and request reconsideration and
withdrawal in light of the remarks contained herein. The Examiner has withdrawn claims 18-
25 from consideration. Claims 1, 4, 10, 17, and 18-28 are pending in this application.

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REJECTION UNDER 35 U.S.C. §102(b)

Claim 26 is rejected under 35 U.S.C. §102(b) as being anticipated by the "Retailing" publication (*hereinafter Retailing*).

The recited reference does not teach all claimed limitations.

It is well settled that to anticipate a claim, the reference must teach every element of the claim, see M.P.E.P. §2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim," see M.P.E.P. § 2131, *citing In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim," see M.P.E.P. § 2131, *citing Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicants respectfully assert that the rejection does not satisfy these requirements.

Claim 26 provides, in pertinent part, "soliciting from a particular vendor site various products which are to be promoted at particular times of the year;" and "preparing articles for inclusion in selective editions of said display, each said commissioned article pertaining to one or more of said solicited products. . . ." The Examiner asserts that *Retailing* discloses soliciting products for promotion from vendors at page 19, column 2, lines 42 - 45; and preparing articles for inclusion in a magazine at page 20, column 1, lines 28 - 40. However, the referenced sections in *Retailing* do not disclose the elements as taught in claim 26.

Page 19, column 2, lines 42 - 45 does not describe a process of soliciting products for promotion. Lines 42 - 45 describe how sales promotion in smaller shops relies on the customer's personal contact with the proprietor. However, further in the same paragraph it states that, "[m]anufacturers, of course, make the fullest use of newspapers, radio and television to promote sales and most shopkeepers take advantage of them." While this passage discloses the use of magazines and newspapers by manufacturers and shopkeepers, it does not describe soliciting, from a particular vendor, products to be promoted. Therefore, *Retailing* does not disclose this limitation.

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Page 20, column 1, lines 28 - 40 describes including articles of general interest into a "firms' own" magazines. However, it does not disclose that the articles actually pertain to any of the promoted products. Instead, lines 30 - 32 describe the use of "attractive advertisements" for promotion of the household and food items. Thus, *Retailing* also does not disclose the claimed limitation. Applicants, therefore, respectfully assert that for the above reasons claim 26 is patentable over the 35 U.S.C. § 102 rejection of record. Furthermore, there are great differences between the claim and the prior art of record, and a person of ordinary skill in the art considering the prior art would not find these differences obvious.

REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1, 4, 10, 17, 27, and 28 are rejected under 35 U.S.C. §103(a) as being unpatentable over selected combinations of *Retailing, Tai*, U.S. Patent No. 4,908,761 (*hereinafter Tai*), and *Degasperi, et al.*, U.S. Patent No. 5,097,981 (*hereinafter Degasperi*).

A Prima Facie case of obviousness has not been established.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. §2143. Without conceding any of the criteria, Applicants assert that the rejection does not satisfy the first criteria.

Claims 1, 4, & 10: *Tai* in view of *Retailing*

The recited combination does not teach or suggest all claimed limitations.

The Office Action admits that *Tai* does not teach displaying the newspapers or magazines in the store. The Office Action attempts to cure this deficiency by introducing *Retailing*, which the Office Action alleges to teach having such limitation. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

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Claim 1 defines "collecting information about the product, the collected information pertaining to practical uses or advantages of the product." *Tai* does not disclose this limitation, nor does the Examiner rely on *Retailing* to supply it. The Examiner asserts that the *Tai* coupons include "specific information about the products," which would have to have been collected prior to incorporation into the coupon. However, as disclosed in *Tai*, the incorporated product information is tracking information included in machine readable form, so that use statistics may be calculated. Col. 3, lns 51-62 & Col. 6, lns 4-38. Claim 1 specifically teaches that the collected information "pertain[s] to practical uses or advantages of the product." The nature and intended use of the information in *Tai* is completely different than the information collected in the present invention. Thus, *Tai* does not teach the claimed limitation. Applicants, therefore, respectfully assert that for the above reasons claim 1 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 4 and 10 depend directly from base claim 1, and thus inherit all of its limitations. Thus, the Applicants respectfully assert that for the above reason, claims 4 and 10 are also patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 17: *Tai* in view of *Retailing*, in further view of *Degasperi*

The recited combination does not teach or suggest all claimed limitations.

The Office Action admits that *Tai* in view of *Retailing* does not teach displaying the newspapers or magazines near the products. The Office Action attempts to cure this deficiency by introducing *Degasperi*, which the Office Action alleges to teach having such limitation. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Claim 17 defines "collecting information about the product, the collected information pertaining to practical uses or advantages of the product." Neither *Tai* nor *Retailing* disclose this limitation, nor does the Examiner rely on *Degasperi* to supply it. The Examiner asserts that the *Tai* coupons include "specific information about the products," which would have to have been collected prior to incorporation into the coupon. However, as disclosed in *Tai*, the incorporated product information is tracking information included in machine readable form,

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so that use statistics may be formulated. Col. 3, lns 51-62 & Col. 6, lns 4-38. Claim 17 specifically teaches that the collected information "pertain[s] to practical uses or advantages of the product." The nature and intended use of the information in *Tai* is completely different than the information collected in the present invention. Thus, *Tai* does not teach the claimed limitation. Applicants, therefore, respectfully assert that for the above reasons claim 17 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 27 and 28: *Retailing*The recited combination does not teach or suggest all claimed limitations.

The Office Action admits that *Retailing* does not teach using brand names in the coupons. The Office Action attempts to cure this deficiency by claiming it would be notoriously obvious to do so. However, this combination, as presented, still does not teach or suggest all limitations of the claimed invention.

Claims 27 and 28 depend directly from independent claim 26. Claim 26 provides, in pertinent part, "soliciting from a particular vendor site various products which are to be promoted at particular times of the year," and "preparing articles for inclusion in selective editions of said display, each said commissioned article pertaining to one or more of said solicited products. . . ." In his rejections under § 102(b), the Examiner asserts that *Retailing* discloses soliciting products for promotion from vendors at page 19, column 2, lines 42 - 45; and preparing articles for inclusion in a magazine at page 20, column 1, lines 28 - 40. However, referenced sections in *Retailing* do not disclose the elements as taught in claim 26.

Page 19, column 2, lines 42 - 45 does not describe a process of soliciting products for promotion. Lines 42 - 45 describe how sales promotion in smaller shops relies on the customer's personal contact with the proprietor. However, further in the same paragraph it states that, "[m]anufacturers, of course, make the fullest use of newspapers, radio and television to promote sales and most shopkeepers take advantage of them." While this passage discloses the use of magazines by manufacturers and shopkeepers, it does not describe soliciting, from a particular vendor, products to be promoted. Therefore, *Retailing* does not disclose this limitation.

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Page 20, column 1, lines 28 - 40 describes including articles of general interest into promotional magazines. However, it does not disclose that the articles actually pertain to any of the promoted products. Instead, lines 30 - 32 describe the use of "attractive advertisements" of the household and food items. Thus, *Retailing* also does not disclose the claimed limitation. Through their dependency, claims 27 and 28 inherit all the limitations of claim 26's. Claim 27 and 28, therefore, teach elements and limitations not disclosed in *Retailing*, nor would such limitations be obvious. Applicants, therefore, respectfully assert that for the above reasons, claims 27 and 28 are patentable over the 35 U.S.C. § 103(a) rejection of record.

DECLARATION OF COMMERCIAL SUCCESS UNDER 37 CFR 1.132

Applicants offer the declaration of Caleb J. Pirtle which demonstrates the commercial success of the claimed invention. Applicants have not previously offered such evidence because they believe that none the references cited by the Examiner teach each and every element of Applicants' invention. Applicants actively expressed this belief in the preceding Amendments by specifically pointing to the absence of several claim limitations in each of the cited references or combinations thereof. Therefore, Applicants did not believe the evidence of their invention's commercial success was necessary to show nonobviousness. Applicants maintain that such reasons for not presenting the attached evidence prior to the outstanding Final Office Action are good and sufficient, and request that the examiner consider the attached declarations.

As set forth in the declaration, the claimed invention has resulted in an economic synergism which would not necessarily be expected considering the industry averages regarding coupon redemption. The Examiner can see the vast disparity between the industry average redemption rate and the rate achieved through use of a preferred embodiment of the present invention. While an improvement of one or two percentage points might be considered a business success, the 400 - 5000% increase over industry standards is evidence of the synergism present in the claimed process. Applicants, therefore, assert that, in addition to the reasons stated above, the vast economic success achieved by the claimed invention in an industry that is well over half a century old is ample evidence of the nonobviousness of the

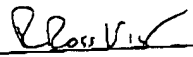
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inventive method. Applicants, thus, request the Examiner to withdraw his 35 U.S.C. § 103(a) rejections of record.

Applicants respectfully request that the Examiner call the below listed attorney if the Examiner believes that a discussion would be helpful in resolving any remaining problems.

Respectfully submitted,


R. Ross Viguet
Registration No. 42,203
Counsel for Applicant

Date: 8/7/00

Fulbright & Jaworski L.L.P.
2200 Ross Avenue, Suite 2800
Dallas, Texas 75201-2784
Telephone: 214-855-8185
Telecopier: 214-855-8200